

REMARKS

The election/restriction requirement has been carefully reviewed. Restriction to one of the following inventions was required under 35 U.S.C. 121: (I) Claims 1-27, drawn to coating method, classified in class 427, subclass 226; and, (II) Claims 28-32, drawn to composition, classified in class 106, subclass 436.

The Office Action stated that the inventions were distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the product composition can be used for making decorative or functional designs: as precursors for forming metal powders or protective metal coatings on substrates; etc.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

The Office Action further stated that this application contains claims directed to the following patentably distinct species: Claim 2: a metal should be selected; Claim 9, a substrate type should be selected; Claim 10, a solution type should be selected; and, Claim 23, a soluble polymer should be selected.

The species are independent or distinct because each group contains diverse, independent, and unrelated species.

Applicant was required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.

Applicant was advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claims as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The Office Action noted that a telephone call was not made to the attorney to request an oral election on the above restriction requirement, because of the complexity of the issues.

Applicants hereby elect Group II, claims 28-32 without traverse.

Further, while the restriction requirement did not set out the patentably distinct species with regards to claims 28-32, the species of metal, solution-type and soluble polymer are present within the elected claims and so these species will be addressed. The species of substrate is not present within the elected claims and so will not be addressed.

So, further, applicants elect yttrium metal, barium metal and copper metal as the "at least two metal precursor species", elect polyethylenimine as the "polymer species" and elect water as the "solution type species". It is submitted that all of claims 28-32 are readable upon these election of species.

A favorable action is solicited.

Respectfully submitted,

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